

and the table sized to accommodate serving a meal to a plurality of individuals in the seating areas.

9. (once amended) A method of restaurant videoconferencing comprising the steps

of:

- a) providing a plurality of videoconferencing booths in each of a number of restaurants, each restaurant in a particular geographic location; and
- b) conducting videoconferencing between users in at least two booths in different restaurant locations while offering food and/or beverages to the users in each booth.

REMARKS

By this amendment, claims 1 and 9 are amended to clarify that the system and method involves a plurality of restaurants, not one restaurant. Currently, claims 1-20 are outstanding.

Claim 1 has also been revised to clarify the booths in each location having the viewing screen so as to be consistent with step (b) of claim 9. Claim 9 is also amended to account for the serving of beverages in the restaurant.

In the pending Office Action, the Examiner has withdrawn the previously-made rejection and has made new rejections primarily based on United States Patent Nos. 4,074,793 and 4,800,438 both to Yuter, hereinafter Yuter I and Yuter II, respectively.

Applicants request reconsideration of the rejection of claims on the basis that a *prima facie* case of obviousness has not been established. This request is made under

the headings of THE INVENTION, THE PRIOR ART AND REJECTION, and THE ARGUMENTS. While the INVENTION section was submitted previously, Applicants include it herein to re-emphasize the fact that neither Yuter patent teaches the inventive concept, whether taken alone or with any of the other references cited in the Office Action.

THE INVENTION

The invention relates to the novel and unobvious combination of a number of features, none of which are taught or suggested by the prior art. That is, the prior art does not teach a videoconferencing restaurant as claimed, and having a number of booths to accommodate a number of people for eating and other services such as videoconferencing, internet access, computer games, etc., particularly over different geographic time zones. This time zone feature significantly increases the number of guests/table turns (seatings) in each restaurant, leading to increased customer accounts and much improved sales and profits.

THE PRIOR ART AND THE REJECTIONS

Independent claim 1 stands rejected under 35 USC 103(a) based on Yuter I when taken in view of Yuter II and previously-cited U.S. Pat. 5,374,953 to Flohr. The Examiner admits that Yuter I does not teach the claim limitations regarding the viewing screen, the plurality of seating areas, video-conferencing, and the sizing of the table.

In response to this deficiency, the Examiner cites Yuter II for the teaching of the use of a more compact telephone with a TV in place of the telephone of Yuter I. The Examiner also alleges that given the teachings of Flohr, it would be obvious to modify the telephone system of Yuter I/II and employ videoconferencing.

The Examiner rejects claim 9 relying on the Yuter I alone and Flohr. The rejection interprets claim 9 to mean one restaurant and concludes that the only difference is the use of videoconferencing. Based on this claim interpretation, the Examiner concludes that it would be obvious to use videoconferencing in the restaurant of Yuter I given Flohr. The Examiner relies on Yuter II to reject claim 17.

ARGUMENTS

The rejections of claim 1 and 9 are flawed in that there is no motivation to combine Flohr with either Yuter I or II without resorting to the hindsight reconstruction of the prior art in light of applicants' own disclosure. Further, even if there was motivation to combine, the combination of the references does not establish a *prima facie* case of obviousness against claim 1 and claim 9.

Regarding Flohr, the Examiner concludes that just because videoconferencing is known, i.e., the teachings of Flohr, one of skill in the art would use it in the restaurant of Yuter. This reasoning fails because the mere fact that videoconferencing is known does not tell the artisan WHY one should modify Yuter I/II. Any rejection under Section 103 must give the reason why the modification is done. The Examiner has not provided the all-important WHY. The purpose of Yuter is to permit voice communication within a single restaurant while the invention connects people via live video in different geographic areas. To date, telephone-based applications alone, in the marketplace or other venues, have not rendered videoconferencing applications or advancements obvious. Thus, there is no basis in fact for the Examiner to use the mere existence of a telephone system to conclude that the claimed videoconferencing application on its face is *prima facie* case of obviousness.

In the Office Action, the alleged reason for modifying Yuter I/II is stated as "because it enables terminals to participate flexibly in multimedia exchanges with media terminals on a network so that it makes a plurality of terminals to conduct videoconferencing even though the selected terminals are located on different networks." Applicants submit that this statement fails unequivocally as a basis to modify Yuter I or II.

Given that Yuter I and II use their phones for ordering, why would one want videoconferencing in such an establishment? The Examiner is concluding obviousness without a reason to do so. The Examiner cannot merely read the specification and conclude that because Yuter I and II use telephones and a TV, and that videoconferencing is known, that the invention is obvious.

Applicants are not claiming to be the first to use videoconferencing. However, Applicants are the first to claim the use of videoconferencing and multimedia access in booths in different restaurants for the improvements described in the instant application. The Examiner is cobbling together the prior art to make a rejection that does not meet the standards imposed by the 35 USC 103.

Likewise, there is no suggestion to use the claimed multi-media access allegedly suggested by United States Patent 5,929,849 to Kikinis in Yuter I/II without employing hindsight.

Besides lacking motivation, the Yuter references do not teach the use of different restaurants as part of the claimed system and method.

Yuter I is an improvement on the old idea of using phones in a restaurant, see col. 1, lines 15-23. Yuter I's improvement in this arena is in the manner of taking orders.

Yuter II is an improvement over Yuter I by providing a more compact phone and through the use of a TV with the phone. As noted by the Examiner, the TV screen must be rotated so that other persons can see it. This compact TV screen is used to convey simple information, i.e., food orders to one person at a time. In contrast, the claim requires a large viewing screen that can be easily and simultaneously seen by all seated at the booth to permit interactive communication, i.e., internet use, videoconferencing, and PC applications.

While Yuter I and II may suggest conversations between patrons and the order department, or even between patrons, i.e., a closed network, see Yuter I, col. 3, lines 44-50, there is absolutely no suggestion in Yuter to go beyond the closed network. In contrast, the main thrust of the invention is to connect patrons in different restaurants/geographic locations.

Claims 1 and 9 have been amended to clarify this aspect of the invention. Accordingly, any further rejection of claims 1 and 9 must address the different restaurant aspect of the claims as now amended.

Neither Flohr nor Kikinis supply the deficiencies in Yuter I or II in this regard. These references have nothing to do with restaurants.

In fact, since ordering using the phones is vital to the Yuter I/II operation, providing communication between restaurants in different locations makes absolutely no sense in the context of these references. One of skill in the art would not be motivated to link the telephones of different restaurants for ordering or meeting people. Put another way, Yuter I and II teach away from the instant invention and cannot serve as a basis to obviate the

invention. This teaching away further substantiates Applicants' contention that the prior art does not obviate the invention.

The fact that Yuter II combines a TV with a telephone does not suggest videoconferencing/internet/PC applications or suggest interaction with other restaurants. Further, the small TV of Yuter II does not meet the limitation that the viewing screen be seen from the plurality of seats as is required by claim 1, or the step of videoconferencing of claim 9.

At this stage, the Examiner is baldly concluding obviousness without an objective basis in fact, which is contrary to the burden imposed on all Examiners to show obviousness and that is reiterated by the Federal Circuit In re **Zurko** 59 USPQ2d 1693 (Fed. Cir. 2001).

For these reasons, claims 1 and 9 are patentably distinguishable over the applied prior art.

Method claim 17 is also distinguishable for the reasons set forth above for claim 1.

The applied references also fail to suggest all of the features of claims 18 and 19 and these claims are also patentable over the applied prior art.

Claims 11 and 20 are also distinguishable in that none of the prior art suggests that the booths be in different countries or countries separated by an ocean. As stated above, eating and videoconferencing in different time zones and/or different countries results in significant increases in restaurant turns, and higher profitability. This benefit is not suggested in the applied prior art and claims 11 and 20 are deserving of their own patent protection.

CONCLUSION

Based on the arguments set forth above, independent claims 1 and 9 are each patentably distinguishable over the reference. Dependent claims 11 and 17-20 are also separately patentable over the applied art. The remaining dependent claims are allowable by reason of their dependency on their respective independent claims.

The Examiner is called upon to support any further rejections of the claims with objective evidence based on the prior art as required by **Zurko**.

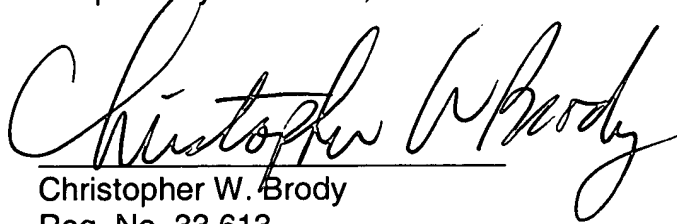
The above constitutes a complete response to all issues raised in the Office Action of September 11, 2001.

If an interview would expedite the prosecution of this application, the Examiner is respectfully requested to telephone the undersigned at 202-835-1753.

A petition for a one month extension of time under 37 CFR § 1.136(a) is hereby made. Payment of \$55.00 is made using the attached PTO-2038. Please charge any shortage in fees due in connection with the filing of this paper, including extension of times fees to deposit account number 50-1088 and please credit any excess fees to such account.

Again, reconsideration and allowance of this application is respectfully solicited.

Respectfully submitted,



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Marked-Up Claims under Rule 1.121

1. (twice amended) A restaurant videoconferencing system comprising:

- a) a first plurality of booths in at least a first restaurant geographic location;
- b) a second plurality of booths in at least a second restaurant geographic location;
- c) [each] at least one booth in each of the first and second locations being equipped with at least one viewing screen and connected via a network providing both videoconferencing between booths in different geographic locations and multi-media access for each booth, wherein each at least one booth has a table and a plurality of seating areas, the plurality of seating areas arranged so that viewing screen is visible from the plurality of seating areas, and the table sized to accommodate serving a meal to a plurality of individuals in the seating areas.

9. (once amended) A method of restaurant videoconferencing comprising the steps of:

- a) providing a plurality of videoconferencing booths in each of a number of restaurants, each restaurant in a particular location [restaurant locations]; and
- b) conducting videoconferencing between users in at least two booths in different restaurant locations while offering [serving] food and/or beverages to the users in each booth.